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30084	7590	04/17/2009	EXAMINER	
DONN K. HARMS			MI, QIUWEN	
PATENT & TRADEMARK LAW CENTER			ART UNIT	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/571,749	EWE, CHOR EE	
	<b>Examiner</b>	<b>Art Unit</b>	
	QIUWEN MI	1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 3/31/09.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-8 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 13 March 2006 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____ .	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

Applicant's amendment in the reply filed on 3/31/09 is acknowledged. Claims 1-8 are pending. **Claims 1-8 are examined on the merits.**

Any rejection that is not reiterated is hereby withdrawn.

### **Claim Objections**

Claims 1-8 remain objected to because of the following informalities: Claims 1-7 recite "a herbal applicator", which is incorrect. The correct recitation should be "an herbal applicator". Appropriate correction is required.

All other cited claims depend directly or indirectly from objected claims and are, therefore, also, objected for the reasons set forth above.

### **Claim Rejections –35 USC § 112, 1<sup>st</sup> New Matter**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-8 are newly rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

This is a new rejection necessitated by the Applicant's amendment filed on 10/20/08.

Claim 1 recites the new claim limitation "generate a material-permeable vapor which is communicated to the skin of the body"; claim 4 recites the new claim limitation "the first and

second attachment means is hook and loop fabric". However, the specification fails to provide any support regarding the description of the new limitations. Therefore, it is not reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, Applicant had possession of "generate a material-permeable vapor which is communicated to the skin of the body"; and "the first and second attachment means is hook and loop fabric" in the invention. Thus, the subject matters of "generate a material-permeable vapor which is communicated to the skin of the body"; and "the first and second attachment means is hook and loop fabric" are new matters that need to be cancelled.

All other cited claims depend directly or indirectly from rejected claims and are, therefore, also, rejected under U.S.C. 112, first paragraph for the reasons set forth above.

#### **Claim Rejections –35 USC § 112, 2<sup>nd</sup>**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 is newly rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This is a new rejection necessitated by the Applicant's amendment filed on 10/20/08.

Claim 8 recites "a flexible herbal pack retainer...configured to retain said herbal pack in said communication when in said engagement and with said herbal pack retainer", and language is very confusing and it is uncertain exactly what Applicant is trying to claim. Therefore, the metes and bounds of claims are rendered vague and indefinite. The lack of

clarity renders the claims very confusing and ambiguous since the resulting claims do not clearly set forth the metes and bounds of the patent protection desired.

### **Claim Rejections –35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are newly rejected under 35 U.S.C. 103(a) as being unpatentable over Church et al (US 6,572,871) in view of Smith, III et al (US 2003/0069618), and further in view of Choi (US 4,657,531).

This is a new rejection necessitated by the Applicant's amendment filed on 10/20/08.

Church et al teach a heating wrap for placement against an injured/painful area of a person's body (thus applied directly on to the skin of the body) and an analgesic cream being placed between the heating wrap and the injured/painful area. Church et al further teach that the preferred list of ingredients for analgesic cream comprising aloe vera gel, garden balsam leaf extracts, coconut waxes, jasmine essence, willow extract, echinacea, horsechestnut extract etc (col 3, lines 60-68; col 4, lines 1-10) (thus an herbal applicator). The added heat from the heating wrap enhances the permeability of the skin and tendency of the cream to permeate into the skin

(thus emit heat to reach a determined vaporizing temperature). The heat wrap may be a pad that includes a flexible sleeve (flexible main housing) for receiving and surrounding the pad, plus a set of straps for holding the pad or pad/sleeve combination on the body area that is to be treated (thus easily adapts to the contours of the body) (thus affixed with an attachment means and a corresponding attachment means is affixed on to the herbal pad retainer, the said attachment means is to facilitate easy removal and attaching of the herbal pad). The preferred heating wrap includes a thin sheet (top member) that will absorb water, which sheet (thus a fabric) may be dampened with water (thus prevent the heat generated from the heater pad from being dispersed to the outside) and inserted between the heating pad (bottom member) (thus made up of two sections, and allow easy removal of the herbal pack for replenishment) (thus contain the heat generated by the heater pad within to heat the herbs effectively) and surrounding flexible sleeve (heater pad retainer), for providing moist heat treatment (see Abstract). Church et al also teach that the preferred heating means is an electrical heating pad that is thermostatically-controlled (thus adjustable temperature controlled, for regulating the required temperature of the heater pad in order for it to vapourize the herbs contained in the herbal pack) (thus maintain the vaporizing temperature at a temperature level below combustion but sufficient to cause the herbs contained in the herbal pack to emit said vapors of herbal essence) (col 1, lines 50-55). At last, Church et al teach that the addition of heat causes a deep-heating of the body tissue, without over-heating the skin, which increases the skin's permeability to the cream, and consequently increased deep-penetration of the herbal (thus it absorbs part of the heat and helps to reduce the vaporizing temperature), analgesic, antiinflammatory, and other ingredients of the cream (col 3, lines 7-15) (thus when the herbs inside the herbal pack are heated, until they vaporize, the herbal pack

retainer then will allow the vaporized herbal essence to permeate through it and onto the skin and at the same time absorb part of the heat the helps to reduce the vapourizing temperature to the curie temperature). Church et al again teach placing the heating wrap over the affected body area and secure firmly yet comfortably with the elastic straps by wrapping the strap ends around the body part to be treated and connecting the hook and loop patches together (claim 5).

Church et al do not teach the herbs generate a material-permeable vapor which is communicated to the skin, emit vapors of herbal essence, a flexible herbal pack retainer configured to retain said herbal pack in said communication when in said engagement and with said herbal pack retainer adapted to allow easy removal and replacement of the herbal pack, or using portable battery.

Choi teaches a therapeutic heating apparatus and more particularly to an electric heating cup which comprises a cotton pad containing extracts of mugwort herb (thus an herbal pack retainer with vapor permeable material) or other pharmaceutical ingredients in the pad. The therapeutic heating appliance is utilized by the patient for treating various portions of the body. Thus, the vapor produced from the medical ingredients of the pad (thus a permeable material) penetrates the body of the patient due to heating energy and pressure (thus emit heat to reach a determined vaporizing temperature) (col 1, lines 5-16). Choi further teaches that a therapeutic heating apparatus comprising a base member having a handle, an electric heater, a detachable or attachable heat conducting plate, a dry pad containing mugwort herb tonics or active ingredients (thus configured to retain said herbal pack in said communication when in said engagement and with said herbal pack retainer adapted to allow easy removal and replacement of the herbal pack), and a cotton pad (thus a permeable material) to cover the pad for portions of the human

body. Thus, the vapor produced from the medicinal ingredients of the pad by heat penetrate into the body of patient with heating energy and pressure for treating and healing up the human body (thus generate a material-permeable vapor which is communicated to the skin, thus emit vapors of herbal essence, thus it absorbs part of the heat and helps to reduce the vaporizing temperature) (col 1, lines 45-55). Choi also teaches the apparatus has a temperature control nub (thus maintain the vaporizing temperature at a temperature level below combustion but sufficient to cause the herbs contained in the herbal pack to emit said vapors of herbal essence).

Smith, III et al teach a method comprising heating the selected area to a sustained skin temperature, using a device comprising a heat source capable of conductively heating the selected area. The method also comprises administering simultaneously a topical composition containing an active agent (see Abstract), such as flavonoid compounds obtained as extracts from natural sources (e.g. plants) [0067] (thus an herbal applicator). Smith, III et al also teach that the term “wearable device”, which includes the term “sleeve”, means a substantially flexible section of material in the form of, for example, a wrap, patch, cuff or a bandage which may be placed on/confirm to which may be held adjacent, selected area of the body (thus a flexible main housing which can be easily attached on to the body). Such as a wrap, patch, cuff or bandage may be formed from a substrate, preferably a disposable substrate (thus allow easy removal of the herbal pack for replenishment). The sleeve may, in addition, be dimensioned and adapted to apply compression. The sleeve in the form of a wrap, patch, cuff or bandage may be held in place by the use of straps or fasteners. For example, one side of the sleeve may be connected to the other side of the sleeve, using buttons, Velcro or the like [0055]. Smith, III et al further teach

that the device can be either actively AC or DC powered (electrical, battery, etc) [0092]. Smith, III et al teach that a heating pad is prepared. Coated thermal resistance wire is sewn to a semi-rigid nylon (thus made up of two sections). Excess mesh is folder over the wire and both sides of the wire and mesh are wrapped with, and sewn to, a polyester nonwoven batting (heater pad retainer). The end of the resistance wire is connected through bimetallic thermal safety switches to an A.C. power source at 120 volts. A controller integral to the power cord includes a phase fired switch to create a user-adjustable temperature control (thus affixed with a flexible heater pad that connects to an electrical power source to be regulated by an adjustable temperature controller) (thus when the herbs inside the herbal pack are heated, until they vaporize, the herbal pack retainer then will allow the vapourized herbal essence to permeate through it and onto the skin and at the same time absorb part of the heat and helps to reduce the vapourizing temperature to a curie temperature). The entire assembly is wrapped and sealed in waterproof vinyl. A covering of soft polyester is wrapped over the vinyl, and two Velcro straps are sewn to the covering [0100]. Smith, III et al further teach that four additional layers of the same substrate, which is thermally insulating, are placed contiguous to the first substrate on the side away from the wires, and sewn together, to provide insulation against heat loss from one side of the pad (thus prevent the heat generated from the heater pad from being dispersed to the outside) but no insulation on the skin in contact side. This arrangement is particularly beneficial in enabling low power and in facilitating therefore, the use of batteries (portable battery) as a power source.

It would have been *prima facie* obvious for one of ordinary skill in the art at the time the invention was made to use the herbs generate a material-permeable vapor which is

communicated to the skin, emit vapors of herbal essence, a flexible herbal pack retainer configured to retain herbal pack to allow easy removal and replacement of the herbal pack from Choi since the therapeutic heating apparatus in Choi yielded beneficial results in treating various portions of the human body without producing herb ash or smoking gas (col 1, lines 29-37), one of ordinary skill in the art would have been motivated to make the modifications to combine the inventions together.

It would have been *prima facie* obvious for one of ordinary skill in the art at the time the invention was made to use the portable battery from Smith, III et al since Smith, III et al teach the heating device with portable battery yielded beneficial results in cosmetic treatment of skin conditions such as regional fat deposits, one of ordinary skill in the art would have been motivated to make the modifications to combine the inventions together.

From the teachings of the references, it is apparent that one of the ordinary skills in the art would have had a reasonable expectation of success in producing the claimed invention.

Thus, the invention as a whole is *prima facie* obvious over the references, especially in the absence of evidence to the contrary.

### Conclusion

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Qiuwen Mi whose telephone number is 571-272-5984. The examiner can normally be reached on 8 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Michele Flood/

Primary Examiner, Art Unit 1655